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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,193	01/10/2000	Shi-Jun Yang	IR 3556	4031

7590 12/23/2004

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EXAMINER

UHLIR, NIKOLAS J

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/480,193

Applicant(s)

YANG ET AL.

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,10,11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5,10,11 and 14-16 is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☒ Claim(s) 3 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to the amendment/arguments dated 10/08/2004. Applicant's amendment does not substantially change the scope of the claims, but the applicant's arguments are deemed persuasive. Accordingly, all of the previous grounds of rejection are hereby withdrawn. However, the case is not in condition for allowance in view of some minor objections and 35 U.S.C. 112 2nd paragraph issues presented below. Once these issues are corrected, it is likely that the case will be passed to issue (please see examiners note below).

Claim Objections

2. Claim 3 objected to because of the following informalities: Applicants claim various types of polymers by their acronyms (i.e. PMMA instead of polymethyl methacrylate). To prevent confusion, a polymers full name should be utilized when possible, as not all polymer acronyms are universally recognized. This is in contradistinction to universally recognized acronyms, such as ASTM (known in the art as American Society of Testing and Materials). Appropriate correction is required.
3. Claim 17 is objected to because part c) of the resin recites "5 40% by weight." This should read "5-40% by weight." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 6 requires 5-60% by weight crosslinked particles comprising 0-100% by weight styrene, 0-100% by weight alkyl methacrylate, and 0-100% by weight alkylacrylate and crosslinking agent. According, claim 6 is open to particles having 0% of each of the recited components. However, claim 6 is dependent on claim 1, which requires a non-zero value for each of the components of the crosslinked particles. Correction is required.

Allowable Subject Matter

6. Claims 1, 5, 10-11, and 14-16 allowed.
7. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art to that of claims 1 and 16 is US4876311 to Hennig. While Hennig does teach particles have a substantially similar composition as those of the claimed invention, Hennig does not teach the claimed particle size distribution or minimum surface roughness. Further, there is no teaching or motivation to one of ordinary skill in the art to modify Hennig so as to arrive at the claimed invention.

Examiners Note

8. The examiner apologizes for any inconvenience caused to the applicant by having them make these minor corrections via conventional amendment practice. Typically, the examiner would call the applicant in order to try and correct these issues via examiners amendment. However, the examiner's last day at the USPTO is on December 30th, 2004. As a result, the examiner felt that these issues could be best handled via standard amendment practice, where time is not so substantially of the essence.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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D. S. NAKARANI
PRIMARY EXAMINER